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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/772,049	02/04/2004	George F. Thagard III	FONTANA.018A	3911
20995	7590	05/31/2006		
KNOBBE MARTENS OLSON & BEAR LLP 2040 MAIN STREET FOURTEENTH FLOOR IRVINE, CA 92614			EXAMINER COONEY, JOHN M	
			ART UNIT	PAPER NUMBER
			1711	

DATE MAILED: 05/31/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/772,049

Applicant(s)

THAGARD ET AL.

Examiner

John m. Cooney

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 March 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 July 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 3-20-06 has been entered.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Roy (4,225,678), alone, or in view of Tzeng et al.(5,965,626).

Roy discloses process for preparing asphaltic foams prepared by preparing molten asphalt and combining it with urethane forming reactants, blowing agent, surfactants, catalysts, and other materials at index values meeting those as claimed (see the entire document).

Roy differs from applicants' claims in that the order of mixing the asphalt component is not so specified as to require addition to the isocyanate component first. However, Roy (see column 3 lines 1-9) specifies adding the molten asphalt component to the reactive and non-reactive components so as to enable forming a polymeric

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product. Accordingly, it would have been obvious for one having ordinary skill in the art to have added the asphaltic component of Roy to any of the components disclosed first during the processing operations for the purpose of providing the asphaltic component within the polymeric foam forming materials with the expectation of success in order to arrive at the processes of applicants' claims in the absence of a showing of new or unexpected results. Additionally, M.P.E.P. 2144.04 IV. C. recites that it has been held that selection of any order of mixing ingredients is *prima facie* obvious (see also *In re Gibson*, 39 F.2d 975, USPQ 230 (CCPA 1930)).

Further, arrangement of the materials such that employment through the administration of separated materials using multiple conventional mixheads disclosed by Roy (see column 7 and example 1, as well as, the entire document) rather than mixing before or during passage through the mixhead would have been an obvious process manipulation within the disclosure of Roy for the purpose of achieving adequate mixing of materials with the expectation of success in order to arrive at the processes of applicants' claims in the absence of a showing of new or unexpected results.

Roy differs from applicants' claims relating to molded part forming recitations in that it does not recite particulars as to forming molded parts from their preparations. However, Tzeng et al. discloses operations for forming a roofing tile or ridge cap wherein a conveyor belt is provided, a granule layer is applied to said belt, a mold comprising a boundary area is then provided with top side open, the molding area is filled with asphaltic foam forming material, the mold area is then covered with a top mold portion, and the materials are cured to form the desired parts. Accordingly, it

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would have been obvious for one having ordinary skill in the art to have employed the processing operations of Tzeng et al. in employment of the materials of Roy for the purpose of making useable roofing products from the processes of Roy so as to arrive at the processes of applicants' claims with the expectation of success in the absence of a showing of new or unexpected results.

The following arguments were previously held and are maintained herein:

Applicants' arguments have been considered but rejection is maintained as proper for the reasons set forth above. It is held and maintained that it is within the purview of the ordinary practitioner having the teachings of Roy before them (see, particularly, column 4 lines 58-64) to add the asphalt component to any of the other ingredients prior to final work-up, including the isocyanate component.

Applicants' arguments have been considered for showings of new or unexpected results. However, fact based showings of new or unexpected results attributable to the addition of the asphalt component to the isocyanate reactant side which are commensurate in scope with the scope of the claims as they stand have not been demonstrated.

The cream time recitations and description of expansion stage effects are seen to be effects attributable to the combinations of materials addressed above, and novelty based on these recitations is not seen. Further, Roy discloses mixing and placing its mixtures in molds for the purposes of integrating mixed and reacted materials and providing formed articles, respectively. Accordingly, novelty based on these claim elements is not seen.

Applicants' recent arguments have been considered, but rejection is maintained for the reasons set forth above. Column 7 and Example 1 demonstrate employment of conventional mix heads within the processing operations of its disclosure to a degree that employment of impingement mixheads are held to be readily envisioned and within

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the purview of the teachings of Roy. Employment of multiple mixheads rather than a single mixhead to achieve the effects of mixing is within the purview of Roy's teaching and would have been an obvious variation arising from what is fairly suggested by the full teachings of Roy.

Clear and convincing showings of new or unexpected results attributable to the multiple impingement mixhead dispensing operations as claimed have not been shown.

Results Must be Unexpected:

Unexpected properties must be more significant than expected properties to rebut a prima facie case of obviousness. *In re Nolan* 193 USPQ 641 CCPA 1977.

Obviousness does not require absolute predictability. *In re Miegel* 159 USPQ 716.

Since unexpected results are by definition unpredictable, evidence presented in comparative showings must be clear and convincing. *In re Lohr* 137 USPQ 548.

In determining patentability, the weight of the actual evidence of unobviousness presented must be balanced against the weight of obviousness of record. *In re Chupp*, 2 USPQ 2d 1437; *In re Murch* 175 USPQ 89; *In re Beattie*, 24 USPQ 2d 1040.

Claims Must be Commensurate With Showings:

Evidence of superiority must pertain to the full extent of the subject matter being claimed. *In re Ackerman*, 170 USPQ 340; *In re Chupp*, 2 USPQ 2d 1437; *In re Murch* 175 USPQ 89; *Ex Parte A*, 17 USPQ 2d 1719; accordingly, it has been held that to

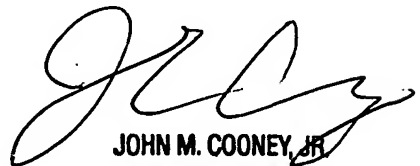
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overcome a reasonable case of prima facie obviousness a given claim must be commensurate in scope with any showing of unexpected results. *In re Greenfield*, 197 USPQ 227. Further, a limited showing of criticality is insufficient to support a broadly claimed range. *In re Lemin*, 161 USPQ 288. See also *In re Kulling*, 14 USPQ 2d 1056.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Cooney whose telephone number is 571-272-1070. The examiner can normally be reached on M-F from 9 to 6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck, can be reached on 571-272-1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


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